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Filed : July 28, 2003

### REMARKS

Claims 1-14 and 30-36 are now pending in the present application, Claims 1, 5 and 7 having been amended and Claims 33-35 having been added. Claims 5 and 7 are amended to correct minor typographical errors, without any other change. Thus, Applicant submit that all the equivalents of the original recitations of Claims 5 and 7 are also equivalents of the present recitations of Claims 5 and 7. The claims set forth above include marking to show the changes made by way of the present amendment, deletions being in ~~strikeout~~ and additions being underlined.

#### The Applied Combination of Swab/Weyer Does Not Make Obvious Claims 1-4, 8, or 11-14

Claims 1-4, 8, and 11-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,769,767 issued to Swab, et al. in view of U.S. Patent No. 4,902,120 issued to Weyer. Applicants respectfully traverse the present rejection. However, in order to expedite prosecution of the present application, Applicants have amended Claim 1. Applicants also expressly reserve the right to further prosecute the original version of Claims 1-7 through continuation practice.

#### Claims 1-4

Swab teaches a wireless ad hoc pico network formed by eyewear and other devices. The eyewear includes a frame and connected to the frame are two temples. The temples may have an apparatus, such as an audio device, a speaker, or a microphone, co-molded within their bodies.

Weyer teaches a headphone earpiece slidably mounted on the temple of an eyeglass. Weyer teaches an earpiece attached to an arm, which is attached to a channel section by means of pivoting sections.

Both Swab and Weyer fail to teach, inter alia, at least one of the size of the speakers and the first range of motion being configured to provide a limited effective range of coverage of about at least 1 1/4 inches and shorter than the earstem, and wherein the first and second mounting mechanisms are configured to allow the first and second speakers, respectively, to pivot a limited, predetermined distance about first and second predetermined pivot axes that are parallel to the first and second linear paths, as claimed.

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Section 2143 of the M.P.E.P. states that to establish prima facie obviousness, the following three requirements must be met:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the Applicant's disclosure.

Applicants contend that the Examiner has failed to establish a prima facie case of obviousness at least because the prior art references when combined fail to teach or suggest all of the claim limitations.

The structure of the device of Claim 1 includes, *inter alia*, first and second speakers mounted to first and second ear stems with first and second mounting mechanisms, respectively, configured to allow the first and second speakers to be translatable along first and second predetermined linear paths in a forward to rearward direction generally parallel to the ear stems, respectively, over a first range of motion, at least one of the size of the speakers and the first range of motion being configured to provide a *limited* effective range of coverage of about at least 1 ¼ inches *and shorter than the earstem*, and wherein the first and second mounting mechanisms are configured to allow the first and second speakers, respectively, to pivot a *predetermined distance* about first and second predetermined pivot axes.

In contrast, the Swab and Weyer references fail to disclose at least one of the size of the speakers and the first range of motion being configured to provide a limited effective range of coverage of about at least 1 ¼ inches and shorter than the earstem, and a speaker mounted to a mounting mechanism that is configured to pivot a predetermined distance about a predetermined pivot axis.

For example, Swab teaches speakers co-molded within the body of an eyeglass temple, *see Swab*, column 5, lines 48-50, 59-63, a speaker mounted on each temple of eyewear, *id.* at column 6, lines 23-24, a speaker removably mounted on a temple, *id.* at column 6, lines 39-41, and a temple housing a removable speaker, *id.* at column 7, lines 9-11.

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However, nowhere does Swab teach or suggest, inter alia, at least one of the size of the speakers and the first range of motion being configured to provide a limited effective range of coverage of about at least 1 ¼ inches and shorter than the earstem, and first and second speakers mounted to first and second ear stems with first and second mounting mechanisms, wherein the first and second mounting mechanisms are configured to allow the first and second speakers, respectively, to pivot a predetermined distance about first and second predetermined pivot axes.

Similarly, Weyer teaches a clip for attaching a headphone earpiece 10 to an eyeglass frame 14. See Weyer, column 2, lines 5-6 and FIG 1. The clip comprises a channel section 20 that clips over a temple of the eyeglasses. Id. at lines 7-10 and FIG. 2. Weyer explains that, “The channel section 20 is slideable along the temple. The earpiece 10 is attached to an arm 22.” Id. at lines 10-11. The “arm is attached to the channel section 20 by means of pivoting sections 16 and 18, which allow for adjustment of the earpiece position.” Id. at lines 12-14. In addition, Weyer also teaches that “the earpiece can be plugged into a slidable socket 36, making earpiece 38 removable.” Id. at lines 46-47 and FIG. 3.

However, Weyer fails to teach, inter alia, at least one of the size of the speakers and the first range of motion being configured to provide *a limited* effective range of coverage of about at least 1 ¼ inches *and shorter than the earstem*. Rather, nothing limits the range of movement of Weyer’s speaker or its arm. Therefore, even if the Swab reference could be combined with the Weyer reference, the combination still would fail to teach all the elements of Claim 1.

Furthermore, there is no motivation provided by the references, or by the Examiner, that one of skill in the art would be motivated to combine the Swab and Weyer references. Swab teaches left and right speakers “removably mounted” to left and right eyeglass temples, respectively. Swab, column 6, lines 39-44 and FIGs. 9-10. Swab’s “removably mounted” mechanism would appear to provided unrestricted movement and positioning of the eyewear speakers. There is no reason or motivation indicated that one would want to restrict Swab’s removably mounted speakers with Weyer’s clip or slidable socket. Finally, there is no indication that there would be a reasonable expectation of success to be found in the cited references themselves.

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Claims 8 and 11-14

Although the following arguments with respect to Swab's failure to teach a compressed audio file storage and playback device disposed in the first ear stem were presented in the Office Action Response of November 14, 2005, the Examiner maintains his rejection of Claim 8 primarily over Swab.

The structure of the device of Claim 8 includes, inter alia, a compressed audio file storage and playback device disposed in the first ear stem. In contrast, the Swab and Weyer references fail to disclose, inter alia, a compressed audio file storage and playback device disposed in an ear stem of an eyeglass.

The Applicants recognize that Swab describes a connected hinge "which permits electrical conduction between the both temples [sic] and the frame enables the sharing of functionality between the left and right temples. It further enables the battery and the circuitry such as the Bluetooth PCB to be on opposing sides to accommodate more circuitry and their functions and to balance the weight and volume." See Swab, column 5, lines 29-35. However, Swab doesn't disclose, inter alia, a compressed audio file storage and playback device disposed in an ear stem of an eyeglass as claimed.

For example, Swab teaches that "eyewear 12 may be *connected to* various audio-playing devices, for example, an MP3 audio player 58, *through the eyewear transceiver 18* coupled to the MP3 player's transceiver 70, as shown in the flow-chart of FIG. 4. . . . Similarly . . . the MP3 player 58 is equipped with *its own transceiver 70* capable of exchanging signals with the transceiver 18. In operation, when MP3 player plays back previously stored music or any other stored audio signal, the transceiver 70 feeds this signal to the transceiver 18 which, in turn, *conveys the signal to the speakers 60 and 62.*" See Swab, column 6, lines 18-44 (emphasis added). It is clear that while Swab may contemplate eyewear communicating with an MP3 player through transceivers 18, 70, Swab does not teach or suggest a compressed audio file storage and playback device disposed in the earstem of eyeglasses, such as claimed in Claim 8.

Similarly, Weyer teaches a temple of an eyeglass having a lead which runs from a connector to a personal stereo unit and a radio receiver incorporated into an eyeglass frame, see Weyer, column 2, lines 21-43 and 65. However, Weyer fails to teach or suggest a compressed audio file storage and playback device disposed in the earstem of eyeglasses, as claimed.

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Therefore, even if the Swab reference could be combined with the Weyer reference, the combination still would fail to teach all the elements of Claim 8.

Additionally, Applicants submit that Claims 11-14 also define over the combination of the Swab and Weyer references, not only because they depend from Claim 8, but also on their own merit.

Therefore, Applicants respectfully request allowance of Claims 1-4, 8, and 11-14 over the cited art.

The Applied Combination of Swab/Weyer/Vogt Does Not Make Obvious Claims 5-7 and 9-10

Claims 5-7 and 9-10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Swab in view of Weyer and further in view of U.S. Patent No. 5,606,743 to Vogt, et al. Applicants respectfully traverse the present rejection. As noted above, Applicants submit that Claim 1 clearly and non-obviously defines over the combination of the Swab and Weyer references. Thus, Applicants submit that Claims 5-7 also define over the prior art, not only because they depend from Claim 1, but also on their own merit. Similarly, as noted above, Applicants submit that Claim 8 clearly and non-obviously defines over the combination of the Swab and Weyer references. Thus, Applicants submit that Claims 9-10 also define over the prior art, not only because they depend from Claim 8, but also on their own merit.

The Applied Combination of Swab/McManigal Does Not Make Obvious Claims 1-4, 8 and 11-14

Claims 1-4, 8 and 11-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Swab in view of U.S. Patent No. 5,327,178 issued to McManigal. Applicants respectfully traverse the present rejection. However, in order to expedite prosecution of the present application, Applicants have amended Claim 1. Applicants also expressly reserve the right to further prosecute the original and previously presented versions of Claim 1 through continuation practice.

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Claims 1-4

As discussed above, Swab teaches a wireless ad hoc pico network formed by eyewear and other devices. The eyewear includes a frame and connected to the frame are two temples. The temples may have co-molded within their bodies an apparatus, such as an audio device, a speaker, and a microphone.

McManigal teaches a loudspeaker carried by a support structure, which includes a closed loop sleeve to be placed over the ear stem of eyeglasses. However, both Swab and McManigal fail to teach, inter alia, first and second speakers mounted to first and second ear stems with first and second mounting mechanisms, respectively, configured to allow the first and second speakers to be translatable along first and second predetermined linear paths in a forward to rearward direction generally parallel to the ear stems, respectively, over a first range of motion, at least one of the size of the speakers and the first range of motion being configured to provided *a limited* effective range of coverage of about at least 1 ¼ inches *and shorter than the earstem*, and wherein the first and second mounting mechanisms are configured to allow the first and second speakers, respectively, to pivot a *predetermined distance* about first and second predetermined pivot axes.

Applicants contend that the Office Action does not establish a prima facie case of obviousness at least because the prior art references when combined fail to teach or suggest all of the claim limitations.

The structure of the device of Claim 1 includes, inter alia, first and second speakers mounted to first and second ear stems with first and second mounting mechanisms, respectively, configured to allow the first and second speakers to be translatable along first and second predetermined linear paths in a forward to rearward direction generally parallel to the ear stems, respectively, over a first range of motion, at least one of the size of the speakers and the first range of motion being configured to provided a limited effective range of coverage of about at least 1 ¼ inches and shorter than the earstem, and wherein the first and second mounting mechanisms are configured to allow the first and second speakers, respectively, to pivot a predetermined distance about first and second predetermined pivot axes.

In contrast, the Swab and McManigal references fail to disclose a speaker mounted to a mounting mechanism that is configured to allow the speakers to be translatable over a first range

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of motion configured to provide a limited effective range of coverage of about at least 1 ¼ inches and shorter than the earstem. Further more, Swab and McManigal fail to teach a speaker mounted to a mounting mechanism that is configured to allow the speaker to pivot a predetermined distance about a pivot axis that is parallel to the linear path, as claimed.

For example, Swab teaches speakers co-molded within the body of an eyeglass temple, see Swab, column 5, lines 48-50, 59-63, a speaker mounted on each temple of eyewear, id. at column 6, lines 23-24, a speaker removably mounted on a temple, id. at column 6, lines 39-41, and a temple housing a removable speaker, id. at column 7, lines 9-11.

However, nowhere does Swab teach or suggest, inter alia, first and second speakers mounted to first and second ear stems with first and second mounting mechanisms, wherein the first and second mounting mechanisms are configured to be translatable over a first range of motion configured to provide a limited effective range of coverage of about at least 1 ¼ inches and short than the earstem. Swab also fails to teach a mounting mechanism configured to allow the first and second speakers, respectively, to pivot a predetermined distance about first and second predetermined pivot axes, such as claimed. As discussed above, the Swab speakers are “removably mounted” to the earstems and include no apparent limit to their adjustability.

Similarly, McManigal teaches a flexible lead 51 connecting a speaker assembly 50 to a personal stereo unit, car phone, or other audio sources. See McManigal, column 6, lines 30-32; see also id. at FIGS. 4 and 5. McManigal explains that “the sleeve deforms to grip the ear stem and conforms to it. The sleeve, although deformed and conforming, is still free to be manually rotated by the user.” Id. at column 8, lines 15-18.

The speaker-holding sleeves of McManigal are free to slide up and down the earstem in an unlimited manner, and are also free to rotate about the eyeglass stems without limit. Thus, McManigal fails to teach, inter alia, a mounting mechanism translatable over a first range of motion configured to provide a limited effective range of coverage of about at least 1 ¼ inches and shorter than the earstem, and pivotability a predetermined distance about a pivot axis, as claimed. Therefore, even if the Swab reference could be combined with the McManigal reference, the combination still would fail to teach all the elements of Claim 1.

In the Office Action the Examiner refers to and reproduces McManigal at column 8, lines 4-23 for the proposition that McManigal does indeed teach “that the first and second mounting

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mechanism are configured to allow the first and second speakers, respectively, to pivot a predetermine distance about first and second predetermined pivot axes that are parallel to the first and second linear path (see figures 4, 5, 9, 11a and 11b).” Office Action, page 7. However, Applicants respectfully submit that neither the quoted passage nor the cited figures, nor anything else in McManigal, stands for the meaning proposed.

Rather, Figures 4, 5, 9, 11a and 11b merely show McManigal’s sleeve coupled to eyeglass earstems. Nothing in the figures teaches or suggests any feature that limits the ability of the user to translate or rotate the speakers or mounting mechanisms as claimed.

In addition, at the cited passage, McManigal merely describes the ability of a user to bring a loudspeaker into a desired position (e.g., a position spaced from the ear or a collapsed and stored position in protected proximity to the lens means). However, nothing in the cited passage, or anywhere else in McManigal, teaches or suggests any feature to limit the ability of a user to translate or rotate the speakers or mounting mechanisms as claimed.

Furthermore, there is no motivation provided by the references, or by the Examiner, that one of skill in the art would be motivated to combine the Swab and McManigal references. As discussed above, Swab teaches left and right speakers “removably mounted” to left and right eyeglass temples, respectively. Swab, column 6, lines 39-44 and FIGs. 9-10. Swab’s “removably mounted” mechanism would appear to provided unrestricted movement and positioning of the eyewear speakers. There is no reason or motivation indicated that one would want to restrict Swab’s removably mounted speakers with McManigal’s sleeve. Finally, there is no indication that there would be a reasonable expectation of success to be found in the cited references themselves.

Additionally, Applicants submit that Claims 2-4 also define over the combination of the Swab and McManigal references, not only because they depend from Claim 1, but also on their own merit.

#### Claims 8 and 11-14

As discussed above, Swab fails to teach or suggest the structure of the device of Claim 8, which includes, inter alia, a compressed audio file storage and playback device disposed in the



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first ear stem. McManigal fails to disclose, a compressed audio file storage and playback device disposed in an ear stem of an eyeglass as well.

McManigal teaches a flexible lead 51 connecting a speaker assembly 50 to a personal stereo unit, car phone, or other audio sources, see McManigal, column 6, lines 30-32; see also id. at FIGS. 4 and 5; however, McManigal fails to teach or suggest a compressed audio file storage and playback device disposed in the earstem of eyeglasses, as claimed. Therefore, even if the Swab reference could be combined with the McManigal reference, the combination still would fail to teach all the elements of Claim 8.

Additionally, Applicants submit that Claims 11-14 also define over the combination of the Swab and McManigal references, not only because they depend from Claim 8, but also on their own merit.

Therefore, for all of the foregoing reasons, Applicants request allowance of Claims 1-4, 8 and 11-14.

The Applied Combination of Swab/McManigal/Vogt Does Not Make Obvious Claims 5-7 and 9-10

Claims 5-7 and 9-10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Swab in view of McManigal and further in view of U.S. Patent No. 5,606,743 to Vogt, et al. Applicants respectfully traverse the present rejection. As noted above, Applicants submit that Claim 1 clearly and non-obviously defines over the combination of the Swab and McManigal references. Thus, Applicants submit that Claims 5-7 also define over the prior art, not only because they depend from Claim 1, but also on their own merit. Also as noted above, Applicants submit that Claim 8 clearly and non-obviously defines over the combination of the Swab and McManigal references. Thus, Applicants submit that Claims 9-10 also define over the prior art, not only because they depend from Claim 8, but also on their own merit.

Claims 30-32 Are In Condition For Allowance

As there are no outstanding rejections of Claims 30-32, Applicants have amended these claims into independent form. Because there is no outstanding rejection or any reason to object to these claims, Applicants submit that Claims 30-32 are in condition for allowance.

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Furthermore, Applicants wish to note that Claims 30-32 have been amended into independent form without any other change. Thus, Applicants submit that all the equivalents of the original recitations of Claims 30-32 are also equivalents of the present recitations of Claims 30-32.

New Claims 33-36

New Claims 33-36 are allowable not only because they also depend from Claim 1, but on their own merit as well.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that the rejections set forth in the outstanding Office Action are inapplicable to the present claims. Accordingly, early issuance of a Notice of Allowance is most earnestly solicited.

The undersigned has made a good faith effort to respond to all of the rejections in the case and to place the claims in condition for immediate allowance. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is respectfully requested to call Applicants' attorney in order to resolve such issues promptly.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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